



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/448,885 | 11/24/1999 | Keizou Baba | 2271/60735 | 5564 |

7590

07/01/2003

Ivan S Kavrukov Esq
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

CARTER, AARON W

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 07/01/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/448,885

Applicant(s)

BABA, KEIZOU

Examiner

Aaron W Carter

Art Unit

2625

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to papers filed on March 26, 2003.

Response to Amendment

2. In response to applicant's amendment received on March 26, 2003, all requested changes to the claims have been entered.

Response to Arguments

3. Applicant's arguments filed on March 26, 2003 have been fully considered, with respect to claims 1-11 they are not persuasive and with respect to the 35 USC 112 rejection of claims 13-15 they are persuasive and the rejection has been withdrawn, but is moot in view of new rejections.
4. With respect to claims 1-11, Applicants argue that the combination of Satoh, Fujino, and Fukushima et al. (Fukushima) does not teach or fairly suggest a personal computer connected with the facsimile and including monitoring software for monitoring a state of memory transmission file of said facsimile. Applicant also submits that Fukushima, Fujino, or Satoh do not disclose displaying a message on a display panel of said personal computer, or when a memory transmission by the facsimile is completed, a message of a completion thereof is displayed on a displaying panel of said personal computer immediately thereafter. Applicants also submit that none of the prior art teaches or suggest that when there exists a file in said facsimile device indicating a communication error, an address of said communication error file

Art Unit: 2625

and a transmission property thereof can be changed from said PC, said file of communication error can be deleted using said PC. Applicant also argues that Satoh does not show or suggest a result monitoring medium executing an operation of sending out a result of the communication performed by said facsimile device to said external terminal periodically.

5. Examiner disagrees. Satoh discloses in Fig. 8 a facsimile (21) connected to a personal computer (20) in which the two devices communicate with each other (15 and 28). Satoh also discloses the ability to monitor the state of a transmission file of said facsimile from the PC (external device) by automatically receiving reports from the facsimile (column 7, lines 35-41 and 62-64, wherein it is inherent that these reports are received periodically) and displaying this report on the display of the PC when received by the PC (column 7, lines 42-44). For example, displaying an indication that document transmission attempted by facsimile has been successfully completed or that there were errors (column 7, lines 46-50, this corresponds to results of the communication performed by the facsimile). In figure 7, Satoh discloses that once the report is received at the PC, such as one indicating an error in communication, the User can then take action by pressing a key and the procedure related to that key stroke is then performed by the facsimile, such as deleting or retransmitting an erroneous communication file although this is not explicitly disclosed by Satoh it would have been obvious. Although Satoh neglects to disclose that the PC specifically is equipped with monitoring software for monitoring a state of a memory transmission file of the facsimile although it is inherent that the facsimile of Satoh contains memory transmission monitoring software since the CPU of the facsimile is capable of sending reports to the PC relating to memory transmission.

Art Unit: 2625

6. Fukushima, on the other hand, discloses a memory transmission monitoring software in figures 8a – 8d, 9a – 9f, 12a – 12b, and 13 when combined with indicating messages of figure 5. For example, when a memory transmission error occurs indication I of fig. 5, “Line Error” is displayed on the display of the facsimile (column 6, lines 48-53 wherein the facsimile could also broadly be considered a PC) or when memory transmission is completed indication h of fig. 5, “Transmission Completed” is displayed. In the case in which a “Line Error” which corresponds to a communication error, the operator given the opportunity to decide whether or not the image is one that the operator desires to transmit, which is obviously eluding to retransmit or delete (column 6, lines 54-57).

7. Fujino discloses allowing the operator to start and stop transmission, which corresponds to begin and abort or delete a transmission and to enter in the destination number or address (column 4, lines 65-67, column 6, lines 15-17 and column 10, lines 49-62), and detect busy lines (Fig. 3). Therefore it would be obvious that the user could detect that a destination address is busy or there is a line error and then delete and/or change the transmission to a new address and transmission properties.

Claim Objections

8. Claim 18 is objected to because of the following informalities:

On line 2 of claim 18, the word more is misspelled “mor”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 6-7 are rejected under 35 U.S.C. 102e as being anticipated by Fukushima et al. (US. 5812279).

11. Regarding claim 6, Fukushima et al disclose a method of monitoring a facsimile device comprising the steps of:

Monitoring a state of a memory transmission of said facsimile (fig. 5 combined with Figs. 8a – 8d, 9a – 9f, 12a – 12b, and 13).

Displaying a message of completion of the memory transmission on a displaying panel fro a personal computer, immediately after the memory transmission is completed (fig. 5 combined with Figs. 8a – 8d, 9a – 9f, 12a – 12b, and 13).

Art Unit: 2625

12. Regarding claim [7], Fukushima et al disclose a method of monitoring a facsimile device comprising the steps of:

Monitoring a state of a memory transmission file of said facsimile (fig. 5 combined with Figs. 8a – 8d, 9a – 9f, 12a – 12b, and 13).

Displaying an error message indicating a communication error in the memory transmission on a displaying panel a personal computer, immediately after the communication error occurs (fig. 5 combined with Figs. 8a – 8d, 9a – 9f, 12a – 12b, and 13 and column 6, lines 48-53 wherein the facsimile could also broadly be considered a PC)).

13. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Satoh (US 5936743).

14. Regarding claim [11], Satoh disclose a facsimile device monitoring system for monitoring a communication result of a facsimile device from an external terminal (fig. 2, col. 3, lines 47-65), comprising:

A facsimile device provided with a result sending -out medium sending out a communication result to an external terminal (Fig. 5, col. 7, lines 35-41; Fig. 9, col. 8, lines 37-62).

An external terminal provided with a display medium displaying and outputting the communication result sent from said facsimile device (fig. 7, col. 8, lines 5-36), and

A result-monitoring medium executing an operation of sending out a result of the communication performed by said facsimile device to said external terminal periodically (fig. 4,

Art Unit: 2625

col. 6, lines 45-59; col. 7, lines 35-41 and 62-64, wherein it is inherent that these reports are received periodically).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh (US. 5936743) in view of Fukushima et al. (US. 5812279).

17. Regarding claims 1 and 2, Satoh disclose a facsimile monitoring system comprising:
A facsimile having an interface, which can be connected with a personal computer (Fig. 8, elements 20 and 21); and

Satoh also discloses the ability to monitor the state of a transmission file of said facsimile from the PC by automatically receiving reports from the facsimile (column 7, lines 35-41 and 62-64) and displaying this report on the display of the PC when received by the PC (column 7, lines 42-44). For example, displaying an indication that document transmission attempted by facsimile has been successfully completed or that there were errors (column 7, lines 46-50). Although Satoh neglects to disclose that the PC specifically is equipped with monitoring software for monitoring a state of a memory transmission file of the facsimile although it is

Art Unit: 2625

inherent that the facsimile of Satoh contains memory transmission monitoring software since the CPU of the facsimile is capable of sending reports to the PC relating to memory transmission.

Fukushima, on the other hand, discloses a memory transmission monitoring software in figures 8a – 8d, 9a – 9f, 12a – 12b, and 13 when combined with indicating messages of figure 5. For example, when a memory transmission error occurs indication I fig. 5, “Line Error” is displayed on the display of the facsimile (column 6, lines 48-53 wherein the facsimile could also broadly be considered a PC) or when memory transmission is completed indication h of fig. 5, “Transmission Completed” is displayed. Therefore it would have been obvious to one of ordinary skill in the art to combine inventions of Satoh and Fukushima. This would provide the PC of Satoh with the monitoring system of Fukushima.

18. Claim 3-5 and 8-10 are rejected under 35 U.S.C. 1 03(a) as being unpatentable over Satoh and Fukushima et al. in view of Fujino (US. 6476935).

19. Regarding claims 3-5, Satoh disclose a facsimile monitoring system comprising: A facsimile having an interface, which can be connected with a personal computer (fig. 8, elements 20 and 21); and

Satoh discloses in Fig. 8 a facsimile (21) connected to a personal computer (20) in which the two devices communicate with each other (15 and 28). Satoh also discloses the ability to monitor the state of a transmission file of said facsimile from the PC by automatically receiving reports from the facsimile (column 7, lines 35-41 and 62-64) and displaying this report on the display of the PC when received by the PC (column 7, lines 42-44). For example, displaying an indication that document transmission attempted by facsimile has been successfully completed or

Art Unit: 2625

that there were errors (column 7, lines 46-50, this corresponds to results of the communication performed by the facsimile). In figure 7, Satoh discloses that once the report is received at the PC, such as one indicating an error in communication, the User can then take action by pressing a key and the procedure related to that key stroke is then performed by the facsimile, such as deleting or retransmitting an erroneous communication file, although this is not explicitly disclosed by Satoh it would have been obvious. Satoh neglects to disclose that the PC specifically is equipped with monitoring software for monitoring a state of a memory transmission file of the facsimile although it is inherent that the facsimile of Satoh contains memory transmission monitoring software since the CPU of the facsimile is capable of sending reports to the PC relating to memory transmission.

Fukushima, on the other hand, discloses a memory transmission monitoring software in figures 8a – 8d, 9a – 9f, 12a – 12b, and 13 when combined with indicating messages of figure 5. For example, when a memory transmission error occurs indication I of fig. 5, “Line Error” is displayed on the display of the facsimile (column 6, lines 48-53) or when memory transmission is completed indication h of fig. 5, “Transmission Completed” is displayed. In the case in which a “Line Error” which corresponds to a communication error, the operator given the opportunity to decide whether or not the image is one that the operator desires to transmit, which is obviously eluding to retransmit or delete (column 6, lines 54-57).

Fujino discloses allowing the operator to start and stop transmission, which corresponds to begin and abort or delete a transmission and to enter in the destination number or address (column 4, lines 65-67, column 6, lines 15-17 and column 10, lines 49-62), and detect busy lines (Fig. 3). Therefore it would be obvious that the user could detect that a destination address is

Art Unit: 2625

busy or there is a line error and then delete and/or change the transmission to a new address and transmission properties.

Therefore it would have been obvious to combine the invention of Satoh with the teachings of Fukushima and Fujino, providing the Satoh's PC with monitoring software of Fukushima, and the manipulation of a communication error as taught by Fujino.

20. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh as applied to claim 11 above, and further in view of Fukushima.

As to claim 12, this claim is rejected for the same reason applied to claims 1 or 2 above.

21. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh as applied to claim 11 above, and further in view of Fukushima and Fujino.

As to claims 13-18, these claims are rejected for the same reasons applied to claims 3-5 above.

Contact Information

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron W. Carter whose telephone number is 703.306.4060. The examiner can normally be reached by telephone between 8am - 4:30pm (Mon. – Fri.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 703.308.5246. The fax phone number for the organization where the application or proceeding is assigned is 703.872.9314 for regular communications.

Art Unit: 2625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.0377.

AWC

awc

June 27, 2003

Aaron W. Carter
Examiner
Art Unit 2625



BHAVESH M. MEHTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600